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09/648,588	08/25/2000	Michel Lesimple	10767-002001	6960

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225 FRANKLIN ST
BOSTON, MA 02110

EXAMINER

COOLEY, CHARLES E

ART UNIT	PAPER NUMBER
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1723

DATE MAILED: 10/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/648,588

Applicant(s)

LESIMPLE, MICHEL

Examiner

Charles E. Cooley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 and 51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 and 51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 08/748,891.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Status

1. The request for reconsideration filed 18 MAR 2004 is persuasive. No fees have been charged for the papers filed 18 MAR 2004. This office action considers the IDS filed 26 SEP 2003 and is a non-final office action.

Priority

2. Acknowledgment is made of applicant's claim for priority under 35 U.S.C. 119. The certified copy has been filed in parent application, Serial No. 098/748,891, filed on 08 OCT 1996.

Information Disclosure Statement

3. Note the attached PTO-1449 forms submitted with the Information Disclosure Statements filed 13 JAN 2003 and 26 SEP 2003.

Reissue Oath/Declaration

4. The reissue oath/declaration filed 15 SEP 2003 is defective because:
(a) it does not identify the mailing or post office address of each inventor.
A mailing or post office address is an address at which an inventor customarily receives his or her mail and may be either a home or business address. The mailing or post office address should include the ZIP Code designation. The mailing or post office address may be provided in an application data sheet or a

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supplemental oath or declaration. See 37 CFR 1.63(c) and 37 CFR 1.76. The declaration merely lists the residence of the sole inventor.

5. Claims 1-37 and 51 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

6. In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed.

Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) which addressees the above deficiencies will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

"Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

Assignee

7. The written consent of all assignees owning an undivided interest in the patent filed 25 AUG 2000 is acceptable.

Surrender of Patent

8. The statement of loss of the original patent filed 15 SEP 2003 is acknowledged.

Drawings

9. The formal drawings filed 15 SEP 2003 are acceptable.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 15, 16, 17, 19/16/15, 19/17/15, 19/15, 20/19/16/15, 20/19/17/15, 20/19/15, 21/19/16/15, 21/19/17/15, 21/19/15, 24/21/19/16/15, 24/21/19/17/15, 24/21/19/15, 28/19/16/15, 28/19/17/15, 28/19/15, 51/15, and 51/16 are rejected under 35 U.S.C. 102(b) as being anticipated by IT 1250630.

IT 1250630 discloses a system for stirring paint in an insertable can comprising a container/can 3 with a can cover and a stirrer within the can; a can support shelf 2 below the can; a stirring head 10 positioned above the shelf that engages the stirrer to rotate the stirrer in the can when the can is inserted on the

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shelf; the stirring head having an interference arm (the element seen below 11 in Fig. 3 and below 12 in Fig. 4) extending from above the location of the can downwardly toward the shelf that mechanically interferes with the can cover as seen in Figs. 4-5; a region between the stirring head and the shelf being free of obstructions as seen in Figs. 4-5; the interference arm being a single arm assembly (e.g., the U-shaped arm seen in Fig. 3) or conversely being two downwardly extending arms (the two vertically disposed planar arms seen below 11 in Fig. 3); the can cover including a spout and the interference arm engages the spout as seen in Figs. 4-5; the shelf 2 being free of pins as clearly seen in the Figures; the stirrer in the can including a drive shaft which protrudes from the can cover as seen in Figs. 4-5; an engaging member 12 extending from the stirring head 10 which engages an upper portion of the drive shaft as seen in Figs. 4-5; the engaging member 12 being connected to a downwardly extending body (the stub shaft connected to and above 12 as seen in Figs. 4-5); the head 10 is connected to a hollow shelf (another one of 2) arranged above the can cover as seen in Figs. 4-5. Regarding claim 28 and the product-by-process limitation therein, the manner in which the stirring head is made (i.e., by molding) does not impart patentability to the claims per MPEP 2113.

12. Claims 29, 30, and 51/29 are rejected under 35 U.S.C. 102(b) as being anticipated by IT 1250630.

IT 1250630 discloses a system for stirring paint in an insertable can comprising a container/can 3 with a can cover and a stirrer within the can having

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a drive shaft; a can support shelf 2 below the can; a stirring head 10 positioned above the shelf that engages the stirrer to rotate the stirrer in the can when the can is inserted on the shelf; the stirring head having an interference arm (the element seen below 11 in Fig. 3 and below 12 in Fig. 4) extending from above the location of the can downwardly toward the shelf that prevents rotation of the cover as the stirrer rotates within the can by mechanically interfering with the can cover as seen in Figs. 4-5; the stirrer in the can including a drive shaft which protrudes from the can cover as seen in Figs. 4-5; an engaging member 12 extending from the stirring head 10 which engages an upper portion of the drive shaft as seen in Figs. 4-5; a region between the stirring head and the shelf being free of obstructions as seen in Figs. 4-5; the head 10 is connected to a hollow shelf (another one of 2) arranged above the can cover as seen in Figs. 4-5; the shaft portion including a plate 4 with upwardly extending fingers and the engaging member 12 being a driver with a blade actuatable with the fingers to effect rotation and the engaging member 12 engages the plate with fingers as seen in Figs. 4-5; the interference arm being a single arm assembly (e.g., the U-shaped arm seen in Fig. 3) or conversely being two downwardly extending arms (the two vertically disposed planar arms seen below 11 in Fig. 3); the can cover including a spout and the interference arm engages the spout as seen in Figs. 4-5; the shelf 2 being free of pins as clearly seen in the Figures. Regarding claim 30 and the product-by-process limitation therein, the manner in which the stirring

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head is made (i.e., by molding) does not impart patentability to the claims per MPEP 2113.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 31-34 and 36-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over IT 1250630.

IT 1250630 discloses the recited subject matter substantially as claimed as noted above and further suggests that the paint mixer device can be constructed from materials that are widely available on the market (Page 2, last paragraph of the translation). IT 1250630 does not however disclose the stirring head body being formed of plastic. In view of the explicit suggestion in IT 1250630 that the paint mixer device can be constructed from materials that are widely available on the market (which is deemed to clearly encompass a well known and widely used material such as plastic), it would have been obvious to one having ordinary skill in the art at the time the invention was made to have formed any of the components of the paint stirring equipment of IT 1250630 from plastic, including the stirring head body, since it has been held to be within the

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general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416; *Sinclair & Carroll Co., Inc. v. Interchemical Corp.*, 65 USPQ 297 (1945).

Furthermore, in view of the fact that the use of plastic vis-à-vis any other common construction material solves no stated problem insofar as the record is concerned and the conclusion of obviousness can be made from the common knowledge and common sense of one of ordinary skill in the art (*In re Bozek*, 416 F.2d 1385, 163 USPQ 545 (CCPA 1969)), it would have been obvious to one of ordinary skill in the art to have formed any of the components of the prior art paint stirring equipment from a well-known construction material such as plastic. *In re Kuhle*, 526 F.2d 553, 188 USPQ 7 (CCPA 1975).

It is observed that artisans must be presumed to know something about the art apart from what the references disclose (see *In re Jacoby*, 309 F.2d 513, 135 USPQ 317 (CCPA 1962)). Moreover, skill is presumed on the part of those practicing in the art. See *In re Sovish*, 769 F.2d 738, 226 USPQ 771 (Fed. Cir. 1985). Therefore, it is concluded that the selection of a well-known material in the art such as plastic would have been obvious to one of ordinary skill in this art, if for no other reason than to achieve the advantage of using a more modern material or a lower cost or more easily fabricated material.

Allowable Subject Matter

15. Claims 18, 22, 23, 25, 26, 27, and 35 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

16. Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection necessitated by the newly applied prior art supplied by Applicant in the IDS filed 26 SEP 2003.

Requirements for Reissue Applications

17. Pursuant to 37 CFR 1.173(c), each amendment submitted must set forth the status of all patent claims and all added claims as of the date of submission. The status to be set forth is whether the claim is pending or canceled (see MPEP 1453).

18. Pursuant to 37 CFR 1.173(c), each amendment submitted must be accompanied by an explanation of the support in the disclosure of the patent for the deletions - see MPEP 1453). An amendment of a new claim" (i.e., a claim not found in the patent, that was previously presented in the reissue application) must be done by presenting the amended "new claim" containing the amendatory material, and completely underlining the claim. The presentation cannot contain any bracketing or other indication of what was in the previous

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version of the claim. This is because all changes in the reissue are made vis-à-vis the original patent, and not in comparison to the prior amendment. Although the presentation of the amended claim does not contain any indication of what is changed from the previous version of the claim, applicant must point out what is changed in the Remarks portion of the amendment or preferably by a marked-up copy of the amended claims. Also, per 37 CFR 1.173(c) and as noted above, each change made in the claim must be accompanied by an explanation of the support in the disclosure of the patent for the change.

Conclusion

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited art shows paint stirring equipment.
20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles E. Cooley whose telephone number is (571) 272-1139. The examiner can normally be reached on Mon-Fri. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Charles Cooley", with a stylized, flowing script.

Charles E. Cooley
Primary Examiner
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7 May 2004